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The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** TOM GIAMMARESSI

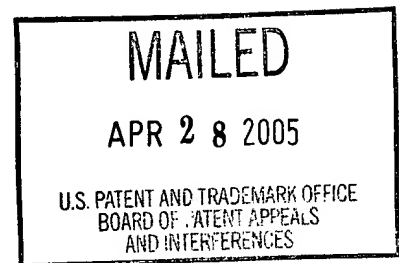
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Appeal No. 2005-0129  
Application No. 09/406,353

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ON BRIEF

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Before KRASS, RUGGIERO, and DIXON, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 17 to 22, 24 to 36, and 38 to 44, which are all of the claims pending in this application.

We REVERSE.

## BACKGROUND

Appellant's invention relates to a video-on-demand (VOD) distribution system where, depending upon the bandwidth available, the system will transmit the most appropriate copy of the media information. An understanding of the invention can be derived from a reading of exemplary claim 17, which is reproduced below.

17. In a video-on-demand (VOD) distribution system comprising provider equipment and subscriber equipment, said provider equipment providing VOD content to said subscriber equipment via a forward channel, said subscriber equipment requesting said VOD content via a back channel, a method comprising the steps of:

determining whether said VOD distribution system has sufficient bandwidth available to provide VOD content requested by a subscriber;

providing, in the event of appropriate bandwidth availability, said requested VOD content to said subscriber using stored content encoded in a manner adapted to utilize said appropriate bandwidth; and

providing, in the event of minimum bandwidth availability, said requested VOD content to said subscriber using stored content encoded in a manner adapted to utilize minimum bandwidth.

The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

|                    |           |                       |
|--------------------|-----------|-----------------------|
| Hang               | 5,115,309 | May 19, 1992          |
| Brown              | 5,822,530 | Oct. 13, 1998         |
| Ravi et al. (Ravi) | 6,292,834 | Sep. 18, 2001         |
|                    |           | (filed Mar. 14, 1997) |

Claims 17-19, 30 and 31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ravi alone. The examiner further relies upon Brown and Hang as further evidence of obviousness for the remainder of the dependent claims. Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 19, mailed Mar. 11, 2004) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 18, filed Dec. 29, 2004) and reply brief (Paper No. 20, filed May 13, 2004) for appellant's arguments thereagainst.

#### **OPINION**

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

At the outset, we note that appellants have elected not to group the claims together as the Examiner had in the rejection. The claims correspond to the independent claims 17 and 30. Therefore, we will select the representative independent claims 17 and 30 and address these claims to the extent that appellant has set forth separate arguments. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not

to make in the brief have not been considered and are deemed to be waived. (**See** 37 CFR § 41.37 (c) (1) (vii) (2004)).

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a ***prima facie*** case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A ***prima facie*** case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is ***prima facie*** obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has

repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the

limitations set forth in independent claims 17 and 30. Claims 17 and 30 were rejected by the Examiner as obvious under 35 U.S.C. § 103(a) over Ravi.

On pages 15-18 of the brief, appellant argues that the invention recited in independent claim 17 represents multiple versions of the stored content which are adapted to utilize the appropriate bandwidth. Unlike the claimed versions of stored content, the Ravi reference discloses a client computer which is able to dynamically select transmission rates to match the bandwidth capacity, but lacks any multiple versions of stored content. (See brief at page 17.) Appellant concludes by stating that claim 17 in the patent application teaches retrieving pre-stored content that is encoded to accommodate various bandwidth levels. (See brief at page 18.)

With respect to independent claim 30, appellant argues that a VOD request is answered by transmitting the stored content, which is pre-stored and encoded in a manner adapted to utilize the appropriate bandwidth. (See brief at pages 19-20). Appellant further argues that Ravi only discloses performance variables that are computed to determine if it is desirable to increase or decrease bandwidth. If there is a determination, the bandwidth is increased or decreased. The change in bandwidth reflects the dynamic selection of transmission rates. Accordingly, appellant concludes that the Ravi reference is silent with regard to stored content encoded in a manner adapted to utilize the appropriate bandwidth.

The Examiner's response only addresses Ravi's ability to utilize different bandwidths, but does not address pre-stored content. Regarding claims 17 and 30, Examiner states "Ravi . . .discloses the claimed 'video on demand Distribution System' . . . comprising of 'provider equipment for providing VOD,' . . . and the claimed 'subscriber equipment requesting the VOD content via a back channel' . . . and forward and backward channel." (See Examiner's Answer at page 4.) Examiner finds the disclosure in Ravi of its dynamic adjustment of the transmission rate of the VOD to optimize the usage of the bandwidth as equivalent to the step of determining whether the VOD distribution has sufficient bandwidth available to provide the VOD content to a subscriber and providing in the event of appropriate bandwidth ability, the requested VOD content to a subscriber using content encoded in a manner adapted to utilize the appropriate bandwidth, and providing VOD content to a subscriber in the event of minimum bandwidth availability using content encoded in a manner adapted to utilize minimum bandwidth. (See Examiner's Answer at page 4.) We disagree with the examiner.

Here, we agree with appellant's assessment of the examiner's application of the prior art to the claimed invention and agree with appellant that VOD's ability to adapt by using different transmission rates for bandwidth does not teach or fairly suggest pre-stored content for different bandwidths. Therefore, the Ravi patent does not teach or

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fairly suggest the invention as recited in claims 17 or 30 and their dependent claims 18-22, 24-29, 31-36, and 38-44.

## CONCLUSION

To summarize, the decision of the examiner to reject claims 17-22, 24-36, and 38-44 under 35 U.S.C. § 103 is reversed.

**REVERSED**

  
ERROL A. KRASS  
Administrative Patent Judge

*Joseph F. Ruggiero*  
JOSEPH F. RUGGIERO  
Administrative Patent Judge

  
JOSEPH L. DIXON  
Administrative Patent Judge

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